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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,910	11/08/2000	Edward J. Walters	26495.101.US02	9069

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COVINGTON & BURLING  
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1201 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20004-2401

EXAMINER
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ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 11/26/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/707,910

Applicant(s)

WALTERS ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 5,25,31-33,68-70,72 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-24,26-30,34-67 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78:
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Claims 1-73 are pending in the present application.

### ***Election/Restrictions***

2. Applicant's election of claims 1-4, 6-24, 26-30, 34-67 and 71 in Paper No. 13 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. This application contains claims 5, 25, 31-33, 68-70, 72 and 73 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Drawings***

4. The drawings were received on May 19, 2003. These drawings are approved.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-4, 6-24, 26-30, 34-55, 58-67 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 1 and 21**, the following limitation vague and lacks proper antecedent basis: *"displaying simultaneously **with the identifiers content elements** of at least one of the records"* [note claim 1, lines 5-6; claim 21 see lines 4-5]. The element "the identifiers content elements" lacks proper antecedent basis. Note the preamble states "identifiers and content elements" see lines 1-2. It is unclear as to what is being displayed simultaneously.

Regarding **claims 2 and 22**, the following limitation lacks proper antecedent basis: *"wherein said selected elements"* [note claim 2 and 22].

Regarding **claims 4 and 24** the following language is vague and unclear: *"identifying and marking records displayed in their entirety in a prior search request"*. The element of marking records and a prior search request is not clear. Note Applicant uses the term "database query" as opposed to "prior search request" in independent claims 1 and 21.

Regarding **claims 60 and 61** the following limitation lacks proper antecedent basis: *"the step of resorting said records"*.

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Claims 2-4, 6-20, 22-24, 26-30, 34-55, 58-59, 62-67 and 71 are rejected based on dependency.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 1-4, 6-24, 26-30, 34-55, 58-59, 62-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. US Patent 5,873,076 in view of Miike et al. US Patent 5,787,414.

Regarding claim 1, **Barr et al.** teaches a method for displaying records responsive to a database query wherein the records are characterized by having identifiers and content elements [note: query server 116, figure 3] comprising the steps of:

displaying a list of identifiers for a plurality of said records [note: element 204 figure 2]; and

displaying simultaneously with the identifiers content elements of at least one of the records [note: element 206 figure 2; figures 4A and 5; col. 12 lines 48-57; col. 14 lines 29-65].

Although Barr et al. teaches the invention substantially as cited above, they do not specifically teach simultaneous display of said list of identifiers and content elements. Miike et al. teaches a user interface with a retrieval result display unit that may be modified for simultaneous display and that enables the user to retrieve a document name and the content of the document [see: col. 24 lines 15-32]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Miike et al. with Barr et al. because Miike et al.'s ability simultaneously display a list of

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items and there content would provide the user with better viewing of the retrieval result and it's equivalent content.

9. Regarding claims 2-4:

(Claim 2) wherein said selected elements comprise the entirety of one of said responsive records [Barr et al., Figure 4A and 5].

(Claim 3) wherein said identifiers comprise case citations [Barr et al., figure 4A and 5].

(Claim 4) further comprising the step of identifying and marking records displayed in their entirety in a prior search request [Barr et al., 206 figure 2 and figure 4A].

10. Regarding claims 6, 8, and 15 note Barr et al.:

(Claim 6) further comprising the step of sorting said responsive records [col. 13 lines 30-67].

(Claim 8) wherein said responsive records include a record name;  
a record citation; a record date; and a record author [note element 400 figure 5].

(Claim 15) further comprising the step of resolving ties in a preceding sort [col. 13 lines 30-67].

11. Regarding claim 7 note Barr et al.:

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further comprising the step of computing the relevance of said responsive records [col. 13 lines 30-67].

12. Regarding claims 9-14:

further comprising the step of computing the relevance of said records ... wherein said list of responsive records is sorted according to record name ... citation ... date ... record author ... relevance of records [Barr et al. Figure 5; also note Miike et al. figure 8].

13. Regarding claims 16-20:

further comprising the step of identifying responsive records that were displayed in their entirety in a prior search ... wherein said responsive records are identified with text ... are identified with icons ... color ... with a browser viewed link designation [Barr et al. figure 4a and 5].

14. The limitations of apparatus claims 21-24, 26-49 parallel method claims 1-4 and 6-20 therefore they are rejected under the same rationale.

15. The limitations of claims 50-55, 58-59, 62-67 and 71, have been addressed above except for the following: wherein said content elements include paragraphs and



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means for identifying a most relevant document and an algorithm [note Barr et al. figure 5, 5A, 5B, col. 23 line 10 through col. 24 line 55].

16. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. US Patent 5,873,076 in view of Miike et al. US Patent 5,787,414 and Jones et al. US Patent 6,415,307 B2.

Regarding claims 56 and 57 Barr et al. teaches a method for displaying records responsive to a database query on a screen where the records are characterized by having identifiers and content elements [note abstract; figure 2, 3, 4A, col. 22 lines 10-37]. Barr et al. does not explicitly teach content elements with identifiers. Miike teaches retrieval of a document name and it's content [col. 24 lines 15-36]. Although Barr et al. teaches at least two panels (i.e. windows) to view the query [col. 22 lines 31-44]; he does not teach specify simultaneous display within panels. **Jones et al.** teaches simultaneously display of a page image in which the story appears side by side in another panel [abstract, figure 6, 8, col. 8 lines 19-35]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mike et al. with Barr et al. because Mike et al's ability simultaneously display a list of items and there content would provide the user with better viewing of the retrieval result and it's equivalent content.

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***Response to Arguments***

17. In the response filed May 19, 2003 Applicant argued the following:

(1) The claims have been amended to clarify that the invention requires the simultaneous display of identifiers of records along with elements for the same records. Neither Barr et al. nor Schmidt teach display of content elements. (2) Barr does not deal with legal material at all. (3) Barr does not teach a prior search request and teaches only a single sort and does not make mention of how to handle two records having the same relevance.

Response: The preamble of independent claims 1 and 21, correspond to Applicant's argument; but the body of amended claims 1 and 21 do not correspond. Note new rejection supra under 35 USC 112 second paragraph. However, a new reference is cited in view of Applicant's argument Miike et al. The element of records being legal material and a sort of two records does not appear in the claims.

18. Applicant's arguments with respect to claims 1-74 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jones et al. US Patent 6,493,731 B1

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Atkins et al. US Patent 5,600,825

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



**GRETA ROBINSON**  
**PRIMARY EXAMINER**

Greta Robinson  
Primary Examiner  
November 20, 2003